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6 Attorneys for Plaintiff and Counterdefendant
Monterey Gourmet Foods, Inc.

8 UNITED STATES DISTRICT COURT
9 NORTHERN DISTRICT OF CALIFORNIA

11 MONTEREY GOURMET FOODS,
INC., a Delaware corporation,

12 Plaintiff,

13 vs.

14 WINDSOR QUALITY FOOD
15 COMPANY LTD., a Texas Limited
Partnership; and DOES 1 through 20,
16 inclusive,

17 Defendants.

No. C08-01316 (JCS)

Case assigned for all purposes to
Hon. Joseph C. Spero

**DECLARATION OF SCOTT S. WHEELER
IN SUPPORT OF COUNTERDEFENDANT
MONTEREY GOURMET FOODS, INC.'S
SPECIAL MOTION TO STRIKE
COUNTERCLAIM OF WINDSOR
QUALITY FOOD CO., LTD. [Cal. Code of
Civil Procedure § 425.16]**

Date: June 6, 2008
Time: 9:30 a.m.
Courtroom A (Hon. Joseph C. Spero)
Trial Date: Not Set

Accompanying Papers: Notice and
Proposed Order; Memorandum of Points &
Authorities; Request for Judicial Notice;
Companion Motion to Dismiss

22 AND RELATED COUNTERCLAIM.
23

24 I, Scott S. Wheeler, declare and state as follows:

25 1. I am Vice President and Chief Financial Officer and a member of the Board
26 of Directors for plaintiff and counterdefendant Monterey Gourmet Foods, Inc. ("MGF"), a
27 Delaware corporation. I have been employed by MGF continuously since 2003.

28 2. MGF is a diversified producer of fresh and frozen gourmet foods,

1 headquartered at 1528 Moffett Street, Salinas, Monterey County, California. MGF is
2 now a publicly traded company that currently operates food manufacturing facilities in
3 Salinas, California, as well as in Seattle, Washington and Eugene, Oregon. MGF's main
4 distribution center is located in Salinas, Monterey County, California.

5 3. MGF presently maintains five (5) general lines of products, under the
6 following brands: 1) Monterey Pasta Company® (based in Salinas); 2) Cibo Naturals™
7 (based in Seattle, Washington); 3) Emerald Valley Kitchen (based in Eugene, Oregon);
8 Sonoma Foods/Sonoma Cheese Company™ (based in Sonoma, California); and Casual
9 Gourmet® (now based in Salinas, California). True and correct copies of the "About Us"
10 and "Our Family of Brands" webpages from MGF's current website depicting these
11 brands is attached hereto, marked Exhibits 1 and 2, and incorporated herein by
12 reference. These product lines are sold in retail stores and club stores throughout North
13 America.

14 4. The Monterey Pasta Company line of products was MGF's original line of
15 products, and remains one of MGF's most important product lines. The current lines of
16 those products include: a) seven (7) different fresh pastas with sauces; b) three (3)
17 different One Step Gourmet frozen pasta dinners; c) four (4) different fresh whole wheat
18 pastas with sauces; and d) additional pasta products sold only in club stores. All of
19 these Monterey Pasta Company products are made in Monterey County, California, and
20 I know from my work at the company, from company records, and from my discussions
21 with other officers and directors of MGF, that such products have always been made in
22 Monterey County, California. All of these Monterey Pasta Company products are
23 advertised and packaged with Monterey Pasta Company branding, which uses MGF's
24 trademarks for Monterey Pasta Company, including MGF's registered marks for
25 *Monterey Pasta Company®* and *Monterey Pasta Company and design®*. These
26 Monterey Pasta products are sold in thousands of retail markets and club stores
27 throughout the United States. These products are also sold in numerous locations in
28 Canada and Mexico.

1 5. MGF's lines of Monterey Pasta Company products are also promoted on
2 MGF's website. Attached hereto, marked Exhibit 3, and incorporated herein by
3 reference is a true and correct copy of the webpage from MGF's current website
4 displaying its seven (7) different fresh pastas, branded as *Monterey Pasta Company®*,
5 and *Monterey Pasta Company—California's Finest™*.

6 6. Attached hereto, marked Exhibit 4, and incorporated herein by reference is
7 a true and correct copy of the webpage from MGF's current website displaying its three
8 (3) different One Step Gourmet frozen pasta dinners, branded as *Monterey Pasta*
9 *Company®*, and *Monterey Pasta Company—California's Finest™*.

10 7. Attached hereto, marked Exhibit 5, and incorporated herein by reference is
11 a true and correct copy of the webpage from MGF's current website displaying its four
12 (4) different fresh whole wheat pastas, branded as *Monterey Pasta Company®*, and
13 *Monterey Pasta Company—California's Finest™*.

14 8. Consistent with the above, MGF has always branded and sold its Monterey
15 Pasta Company lines of products under its trademarks for Monterey Pasta Company.
16 Those trademarks have been and are important and vital to MGF in the branding of that
17 line of products, and for customers to identify those lines of products. As such, the
18 Monterey Pasta Company trademarks, including its registered marks, are vital to our
19 company, and for that reason MGF seeks to protect those marks from infringing or
20 confusing use by others, particularly within the food business.

21 9. While I was not present at the time, I know from my work at the company,
22 from review company records, from my discussions with other officers and directors of
23 MGF, and from my review of the corporate records and history for MGF and its
24 predecessor entities (see Items 6 and 7 in accompanying Request for Judicial Notice),
25 that the original operations of Monterey Pasta Company were founded in the late 1980's
26 by Pamela Burns and Floyd and Sarah Hill, who made pasta by hand out of a storefront
27 location at 596 Lighthouse Avenue, in the City of Monterey, California. Later, these
28 founders incorporated the business as Burns & Hill, Inc. ("BHI"), which continued for a

1 time to operate at the location on Lighthouse Avenue, in Monterey. BHI was the
2 applicant for the first registration of the trademark for *The Monterey Pasta Company and*
3 *design®* (Reg. No. 1,664,278), a true and correct copy of which is attached hereto,
4 marked Exhibit 6, and incorporated herein by reference.

5 10. While I was not present at the time, I know from my work at the company,
6 from review company records, from my discussions with other officers and directors of
7 MGF, and from my review of the corporate records and history for MGF and its
8 predecessor entities (see Items 6 and 7 in accompanying Request for Judicial Notice),
9 that Monterey Pasta Company ("MPC") was originally a California corporation, that later
10 was merged into a Delaware corporation by the same name, and that MPC (first
11 California and then Delaware) succeeded to the Monterey Pasta Company business that
12 had been operated by BHI. On that same basis, I also know that MPC has at all times
13 continued to make the Monterey Pasta Company lines of product solely in Monterey
14 County, California, first in Monterey, and then later in Salinas.

15 11. On or about August of 2004, MPC changed its name to MGF, which is the
16 plaintiff and counterdefendant in this action. At all times since, MGF has had its principal
17 offices and manufacturing facilities for its Monterey Pasta Company lines of product in
18 Salinas, Monterey County, California. Following this name change, MGF, through its
19 attorneys, recorded a name change document for Registration No. 1,953,489 for its
20 *Monterey Pasta Company®*. Trademark with the USPTO indicating that the registrant's
21 name had changed from MPC to MGF, as evidenced by the USPTO's Trademark
22 Assignment Abstract of Title webpage for that trademark, a copy of which is attached as
23 Exhibit 9 to MGF's accompanying Request for Judicial Notice.

24 12. I am unaware of any material misstatements or failures to disclose material
25 information by MGF or any of its predecessors in any of their applications to register any
26 trademark with the USPTO, including the registered trademarks for *Monterey Pasta*
27 *Company®*. I have reviewed the registrations for those marks registered as Nos.
28 1,664,278 and 1,953,489, which are attached hereto, marked Exhibits 6 and 7

1 respectively, and incorporated herein by reference, and believe them to have been true
2 and accurate when made.

3 13. The identification of the registrant in Registration No. 1,664,278 (Ex. 6) as
4 "UBURNS & HILL, INCORPORATED" is erroneous, and I believe a typographical error.
5 Based on the information known to me, including the corporate records and history for
6 MGF and its predecessors (see Items 6 and 7 in accompanying Request for Judicial
7 Notice), the true name of the registrant was Burns & Hill, Incorporated. Other than that, I
8 am informed and believe that the information stated on Registration Nos. 1,664,278 and
9 1,953,489 (Exhibits 6 and 7) was true and correct at the time that the applications were
10 made to register those marks, including the fact that BHI was located and making
11 Monterey Pasta Company products at 596 Lighthouse Avenue in the City of Monterey,
12 as of September of 1990, the time that it applied for registration of the mark registered as
13 No. 1,664,278 (Exhibit 6).

14 14. In its application to register the *Monterey Pasta Company* trademark now
15 registered as No. 1,953,489 (Exhibit 7), MGF (then known as MPC) claimed ownership
16 of the mark previously registered as No. 1,664,278 (Exhibit 6).

17 15. I declare under penalty of perjury under the laws of the State of California
18 and the United States of America that the foregoing is true and correct and of my own
19 personal knowledge, except as to those matters stated on information and belief, and as
20 to those matters I believe them to be true and correct.

21 Executed this 30th day of April, at Salinas, California.

22
23 
24 Scott S. Wheeler

25
26
27 208531.1

EXHIBIT 1


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About Us

Monterey Gourmet Foods was launched as the Monterey Pasta Company, a 400 square foot storefront on Lighthouse Avenue in Monterey, California in 1989. The Company produced small quantities of gourmet pastas and sauces using food processors and hand operated pasta makers. It sold its hand-made products to local grocery stores and restaurants on the Monterey Peninsula.

[Casual Gourmet Foods, Inc.](#) | [Cibo Naturals](#) | [Emerald Valley Kitchen](#)
[Monterey Pasta Company](#) | [Sonoma Cheese Company](#)



For more information or questions about our products please [contact us](#).

Monterey Gourmet Foods, Inc.

1528 Moffet Street Salinas, CA 93908 | Phone: 831-753-6262 | Fax: 831-753-6255 | [Contact Us](#)

[Leadership Team](#)

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EXHIBIT

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EXHIBIT 2



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Our Family of Brands

[Casual Gourmet Foods, Inc.](#) | [Cibo Naturals](#) | [Emerald Valley Kitchen](#)
[Monterey Pasta Company](#) | [Sonoma Cheese Company](#)



CIBO NATURALS™



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New Retail Packaging



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- Our Chefs
- Pasta Basics
- New Retail Packaging
- One Step Gourmet
- Whole Wheat Pastas


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One Step Gourmet entrees



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- [Pasta Basics](#)
- [New Retail Packaging](#)
- [One Step Gourmet](#)
- [Whole Wheat Pastas](#)

New One Step Gourmet entrees from Monterey Gourmet Foods are an exciting new experience in dining. Everything that you need for a gourmet meal is included in just one bag!



For more information on our One Step Gourmet product line, click on each individual product below.

EXHIBIT

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tabbles



Grilled Chicken and Garlic Cheese Tortelloni



Shrimp and Garlic Cheese Tortelloni



Chicken and Broccoli with Tortelloni



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EXHIBIT 5

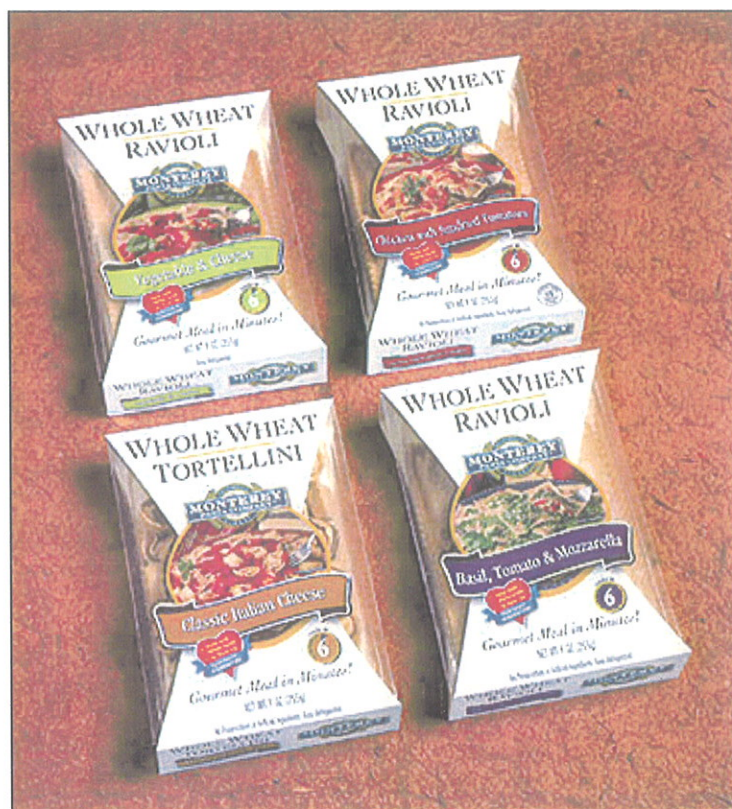

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Whole Wheat Pastas



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- [Pasta Basics](#)
- [New Retail Packaging](#)
- [One Step Gourmet](#)
- [Whole Wheat Pasta](#)

In keeping with their tradition of quality and innovation - Monterey Pasta Company's line of Whole Wheat pastas were created with today's pasta lover in mind. An excellent source of dietary fiber, Whole Wheat pastas from Monterey Pasta combine gourmet fillings and flavors with delicious whole wheat dough made with whole grains. Try all of Monterey Pasta's new Whole Wheat pastas and taste the healthy difference yourself!



For more information on our Whole Wheat Pastas,
click on each individual product below.

EXHIBIT
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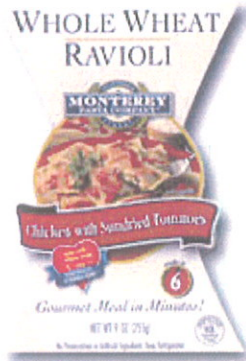
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Whole Wheat
Vegetable and Cheese Ravioli



Whole Wheat
Tomato, Basil and Mozzarella Ravioli



Whole Wheat
Roasted Chicken and Sundried Tomato Ravioli



Whole Wheat
Classic Italian Cheese Ravioli



For more information or questions about our products please [contact us](#).

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EXHIBIT 6

Int. Cl.: 30

Prior U.S. Cl.: 46

Reg. No. 1,664,278

United States Patent and Trademark Office Registered Nov. 12, 1991

TRADEMARK
PRINCIPAL REGISTER



UBURNS & HILL, INCORPORATED (CALIFOR-
NIA CORPORATION)
596 LIGHTHOUSE AVE.
MONTEREY, CA 93940

FOR: FRESH PASTA AND SAUCES, IN
CLASS 30 (U.S. CL. 46).

FIRST USE 6-0-1989; IN COMMERCE
7-0-1989.

NO CLAIM IS MADE TO THE EXCLUSIVE
RIGHT TO USE "PASTA COMPANY", APART
FROM THE MARK AS SHOWN.

THE LINING IS A FEATURE OF THE MARK
AND IS NOT INTENDED TO INDICATE
COLOR.

SER. NO. 74-099,432, FILED 9-24-1990.

KENNETH D. BATTLE, EXAMINING ATTOR-
NEY

EXHIBIT

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EXHIBIT 7

Int. Cl.: 30

Prior U.S. Cl.: 46

United States Patent and Trademark Office Reg. No. 1,953,489
Registered Jan. 30, 1996

TRADEMARK
PRINCIPAL REGISTER

MONTEREY PASTA COMPANY

MONTEREY PASTA COMPANY (CALIFORNIA
CORPORATION)
4125 BLACKHAWK PLAZA CIRCLE, SUITE 200
DANVILLE, CA 94506

FOR: PASTA AND SAUCES, IN CLASS 30
(U.S. CL. 46).

FIRST USE 6-0-1987; IN COMMERCE
6-0-1987.

OWNER OF U.S. REG. NO. 1,664,278.
NO CLAIM IS MADE TO THE EXCLUSIVE
RIGHT TO USE "PASTA COMPANY" , APART
FROM THE MARK AS SHOWN.

SER. NO. 74-802,510, FILED 6-17-1994.

ZHALEH DELANEY, EXAMINING ATTOR-
NEY

